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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,106	02/11/2004	Eric Bornstein	BORNE40593	2676
7590 07/10/2008				
G. Matthew McCloskey McDermott Will & Emery LLP 28 State Street Boston, MA 02109-1775				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3735				
NOTIFICATION DATE		DELIVERY MODE		
07/10/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

### Office Action Summary

**Application No.**

10/776,106

**Applicant(s)**

BORNSTEIN, ERIC

**Examiner**

david shay

**Art Unit**

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on April 4, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 8, 34, 35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 8, 34, 35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

With regard to the rejection including the L'Esperance, Jr., applicant argues that since L'Esperance, Jr. does not teach one aspect of the claims (the particular wavelengths). Applicant also argues that the claimed wavelengths are critical because they produce unexpected results. However, there is no evidence of record that the results of the use of these particular wavelengths produces any unexpected results when used in the method taught by L'Esperance. Thus while the MPEP citations relating thereto are noted, it is not clear that they apply here. Thus, while the reference to L'Esperance is still deemed applicable to the claims, the examiner concedes that the one of ordinary skill in the art would not seek to combine it with Neuman et al. Thus this rejection has been withdrawn.

With regard to the rejection based on Parker et al, applicant's arguments appear to be drawn to the rejections set forth in the office action mailed November 2, 2007. However, this rejection was not applied to the claims in the most recent office action, mailed February 25, 2008 and as such are not convincing with regard to the combination of Parker et al and Rao et al applied therein.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 43 is indefinite because what ranges are intended to be encompassed are not clear, as for example the range of 100 nm to 10,000 nm is a range which "comprises 870 nm".

Claims 34, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Rao et al. Parker et al teach applying multiple wavelengths to the body by separate channels at numerous wavelengths in each of applicant's claimed ranges. Rao et al teach production of a wavelength range encompassing the entirety of applicant's wavelength range with a titanium sapphire laser. It would have been obvious to the artisan of ordinary skill to employ the laser of Rao et al in the device of Parker et al, since this would produce the desired wavelengths at precisely controllable wavelength, power, and intensity values, thereby enabling more accurate measurement, thus producing a device such as claimed.

Claims 35 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Rao et al as applied to claims 34 and 37, and further in combination with Chaiken et al. Chaiken et al teach the use of a power of at least 100 mW for performing non-invasive measurements. It would have been obvious to the artisan or ordinary skill to employ the power levels of Chaiken et al in the combined method of Parker et al and Rao et al, since this results in enhanced spectral information related to the concentration of the analyte, thus producing a device such as claimed.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al in combination with Rao et al as applied to claims 34 and 37, and further in combination with Rosenthal. Rosenthal teaches a device with two optical channels in a finger clip. It would have been obvious to the artisan or ordinary skill to employ a finger clip with two optical channels in the device of Parker et al, since the finger is a convenient and conventional place to measure blood glucose, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent Application No. 11/825,550. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent Application No. 11/841,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent Application No. 11/981,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass

the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-64 of U.S. Patent Application No. 11/997,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9, 10-18, 29, 34, 35, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of

U.S. Patent Application No. 12/019,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application anticipate the claims of the instant application. Accordingly, instant application claims are not patentably distinct from the copending application claims. Here, the copending application claims require elements A, B, C, and D while instant application claims only requires elements A, B, and C. Thus it is apparent that the more specific copending application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed December 4, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/  
Primary Examiner, Art Unit 3735